

### **REMARKS**

Claims 1-21 are pending in the present application. Reconsideration of the claims is respectfully requested.

#### **I. Teleconferences with Examiner Fadok**

Applicant thanks Examiner Fadok for the courtesy extended to Applicant's representative during the January 24, 31, and February 01, 2005 telephone conferences. During the January 24 teleconference, the Examiner and Applicant's representative discussed the omission of claim 13 by the Examiner from the originally identified groups of species in the Office Action, dated January 5, 2005. The Office Action requiring election/restriction of claims, under 35 U.S.C. § 121, contained the following three groups of species:

- Group IA - Claims 1, 2, 3, 4, 7, 8, 9, 10, 11, 14, 15, 16, 17, 18, 21;
- Group IB - Claims 1, 2, 3, 5, 8, 9, 10, 12, 15, 16, 17, 19;
- Group IC - Claims 1, 2, 3, 6, 8, 9, 10, 14, 15, 16, 17, 20.

(Office Action, dated January 5, 2005, Page 3).

However, Examiner Fadok stated during the telephone conversation that the three groups of species were as follows:

- Group IA - Claims 1, 2, 3, 4, 7, 8, 9, 10, 11, 14, 15, 16, 17, 18, 21;
- Group IB - Claims 1, 2, 3, 5, 7, 8, 9, 10, 12, 14, 15, 16, 17, 19, 21;
- Group IC - Claims 1, 2, 3, 6, 7, 8, 9, 10, 13, 14, 15, 16, 17, 20, 21.

During the January 31 and February 01, 2005 teleconferences, Examiner Fadok and Applicant's representative discussed that method claims 4, 5, and 6, which are representative of the alleged species, are not mutually exclusive claims but merely variations of the same embodiment of the present invention. It is the Applicant's representative's understanding that Examiner Fadok agreed that the claims are not mutually exclusive and will therefore withdraw the Restriction Requirement if Applicant's Response contains that argument. The substance of the interview is summarized in the remarks of Section II, which follows below.

**II. 35 U.S.C. § 121**

The Office Action requires a restriction to one of the following sets of claims:

Group IA - Claims 1, 2, 3, 4, 7, 8, 9, 10, 11, 14, 15, 16, 17, 18, 21;

Group IB - Claims 1, 2, 3, 5, 7, 8, 9, 10, 12, 14, 15, 16, 17, 19, 21;

Group IC - Claims 1, 2, 3, 6, 7, 8, 9, 10, 13, 14, 15, 16, 17, 20, 21.

In response to the Restriction Requirement, Applicant **provisionally elects** Group IC, claims 1, 2, 3, 6, 7, 8, 9, 10, 13, 14, 15, 16, 17, 20, and 21, **with traverse**.

Applicant respectfully submits that the requirement of election in this case is not proper and therefore requests that Examiner Fadok withdraw the Restriction Requirement. Manual of Patent Examining Procedure (MPEP) § 806.04 (f), Claims Restricted to Species, by Mutually Exclusive Characteristics, states that "[c]laims to be restricted to different species must be mutually exclusive." Previously amended claims 4, 11, and 18, 5, 12, and 19, and 6, 13, and 20 of the present invention are representative of the three alleged species, respectively. Claims 4, 5, 6, 11, 12, 13, 18, 19, and 20 are not mutually exclusive but merely variations of the same embodiment of Applicant's current invention.

Dependent method claim 4, which is representative of computer program product claim 11 and apparatus claim 18, reads as follows:

4. The method according to claim 1, wherein the discount scheme selected is based on a wireless communication plan used by a customer.

Dependent method claim 5, which is representative of computer program product claim 12 and apparatus claim 19, reads as follows:

5. The method according to claim 1, wherein the discount is computed using a discount scheme from the plurality of discount schemes that produces greatest savings for a customer.

Dependent method claim 6, which is representative of computer program product claim 13 and apparatus claim 20, reads as follows:

6. The method according to claim 1, wherein the discount scheme selected is based on a classification of a customer, and wherein the classification includes a type of product the customer is interested in purchasing, and wherein the classification includes regular customers, and wherein a regular customer is determined based on a customer's purchase histories.

Dependent method claims 4, 5, and 6 are not mutually exclusive because the discount scheme recited in claim 5, which produces the greatest savings for a customer, may be based on the customer classification recited in claim 6, or possibly may include the customer's wireless communication plan recited in claim 4. Consequently, claims 4, 5, and 6 are related variations of the same embodiment of Applicant's current invention and not mutually exclusive. Therefore, according to MPEP § 806.04 (f), the restriction of dependent claims 4, 5, and 6 to different species is improper because the claims are not mutually exclusive. As a result, Applicant respectfully urges that the restriction requirement be withdrawn.

In addition, Applicant respectfully submits that the Examiner has not met the burden of making a *prima facie* showing of a serious burden on the Examiner, as is required in order to make a restriction or election requirement. MPEP § 808.02, Related Inventions, states that where related claimed inventions are shown to be distinct, the Examiner in order to establish reasons for insisting upon restriction/election, must show by appropriate explanation one of the following: (A) The distinct inventions fall under different subject matter classifications (e.g., patent classifications); (B) The distinct inventions have separate status in the art, notwithstanding being classified together; or (C) It is necessary to search for one of the distinct inventions in places where no pertinent art to the other distinct inventions is shown (i.e., different field of search). Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. (MPEP, § 808.02).

In the present case, Examiner Fadok has made no such showing in the current Office Action. Examiner Fadok has listed three overlapping groups of claims, but has not

provided any basis upon which the claims cannot be examined together without imposing a serious burden on him of the type specified in MPEP § 808.02. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (*MPEP*, § 803). In view of §§ 808.02 and 803 of the *MPEP*, Applicant respectfully submits that if Examiner Fadok is unable to make a showing of serious burden, then no restriction of the claims should be required of Applicant. Consequently, Applicant traverses the election requirement on the grounds that a sufficient showing of a serious burden on the Examiner has not been made.

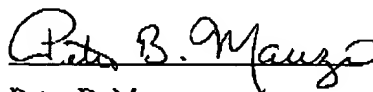
Accordingly, Applicant respectfully requests that the election requirement be withdrawn. Please note that Applicant has based the election requirement traversal on grounds that do not relate to the distinctiveness of the claims. No statement or representation in this Response should be interpreted as an admission that the claims are not patentably distinct with respect to each other.

### III. Conclusion

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 02/04/05

Respectfully submitted,



Peter B. Manzo  
Reg. No. 54,700  
Yee & Associates, P.C.  
P.O. Box 802333  
Dallas, TX 75380  
(972) 385-8777  
Attorney for Applicant